



BLAKELY SOKOLOFF  
TAYLOR & ZAFMAN LLP  
SEVENTH FLOOR  
12400 WISHIRE BLVD.  
LOS ANGELES, CA 90025

COPY MAILED

JAN 2 2 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of  
McKeen, et al.  
Application No. 09/672,368  
Filed: 28 September, 2000  
Attorney Docket No.: 42390P9575

This is a decision on the Renewed Petition to Withdraw the Holding of Abandonment under 37 C.F.R. §1.181,<sup>1</sup> filed via FAX on 18 December, 2001.

The petition is **DISMISSED**.<sup>2</sup>

**NOTES:**

- (1) This is the second review of this matter. There will be no further reconsideration.
- (2) Petitioner's only relief is to seek revival under the provisions of 37 C.F.R. §1.137(b), alleging unintentional delay in triggering the abandonment.

This provision requires that Petitioner submit: (a) the required reply (herein, the proper responses, including fees, to the Notice of Missing Parts, a copy of which is enclosed herewith); (b) the petition fee; (c) the statement that "the entire delay from the due date of the reply until the filing of a grantable petition was unintentional; and (d) a Terminal Disclaimer and fee where required.

<sup>1</sup> The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

**§1.181 Petition to the Commissioner.**

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. \* \* \*

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. \* \* \*

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. \* \* \*

<sup>2</sup> As discussed, *infra*, Office records indicate that Petitioner failed to pay the petition fee when the first petition was filed 15 November, 2001; further, as of this writing Petitioner has not been charged for this second petition. Pursuant to Petitioner's authorization, the two petition fees, each of \$130.00, for a total of \$260.00, are charged to Deposit Account 02-2666.

Petitioner's failure to seek such relief within two months of the date of this decision may be considered intentional delay, which would be a permanent bar to revival.

### BACKGROUND

A review of the record reveals:

- the instant application was filed on 28 September, 2000;
- on 17 November, 2000, the Office mailed a Notice of Missing Parts, requiring that a properly signed oath or declaration (i.e., an oath or declaration signed by all of the named inventors) be filed within two months (on or before 17 January, 2001) by the Applicants and that the missing parts surcharge of \$130.00 accompany the filing;
- Petitioners failed to respond properly and timely to the Notice, and the application became abandoned after midnight 17 January, 2001;<sup>3</sup>
- no Notice of Abandonment was mailed before the Petition to Withdraw the Holding of Abandonment (styled as a "Petition to the Commissioner for Acceptance of Declaration and to Correct Office Error Under 37 C.F.R. §1.182" (sic)) on 15 November, 2001, which was considered appropriately under 37 C.F.R. §1.181 and dismissed on 29 November, 2001, for failure to make a proper showing in support of the petition;<sup>4</sup>
- this petition followed on 18 December, 2001, and is accompanied by a declaration by Thomas M. Coester (Reg. No. 39,637) that he has reviewed his file(s) and there is no Notice of Missing Parts contained in the file(s).

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>5</sup> And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the

---

<sup>3</sup> Petitioner accurately notes that First, Second and Third Status Inquiries were made on 2 February, 4 April and 27 July, 2001. However, those inquiries did not commence until weeks after the application was abandoned.

<sup>4</sup> No petition fee was paid at that time. Petitioner paid only the surcharge for the late filing of the oath or declaration in response to the Notice of Missing Parts.

<sup>5</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

requirements for a petitioner to revive a previously unavoidably<sup>6</sup> or unintentionally, respectively, abandoned application under this congressional grant of authority. Further, Petitioner must evidence at least such diligence in addressing a question of abandonment as one must evidence in the prosecution of the application--i.e., such diligence as one would give to one's most important business affairs.<sup>7</sup>

Moreover, the courts have determined the construct for properly supporting an allegation of non-receipt of an Office action in seeking withdrawal of a holding of abandonment.<sup>8</sup>

#### Allegation of Non-Receipt of Office Action

Petitioner cites as the alleged basis for his request that the Office withdraw the holding of abandonment a statement that Petitioner did not receive Office action in question.

However, there is no documentation submitted in support of this allegation, save Petitioner's statement and docket sheets. There are no copies of the mail-receipt log(s); no description of Petitioner's procedures for collecting and reviewing in-coming mail and or statement from any staff support personnel in Petitioner's who handle those responsibilities:

- (1) the method used for recording/tracking incoming and outgoing communications regarding applications in general and this application in particular, and
- (2) the manner in which this application was in fact handled by the applicant and/or those acting on behalf of the applicant.

Moreover, there are no copies of Petitioner's office documents/records indicating:

- what was received in the weeks after mailing of the Notice, and
- evidencing the difference in Petitioner's records as to the receipt of the Notice of Abandonment as contrasted with the alleged non-receipt of the November 2000 Notice of Missing Parts.

Whether or not Petitioner can find a document in his files is of no moment here. A document may be received, then misfiled, and never be found again.

---

<sup>6</sup> The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional. Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887). See also: In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). Decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition cannot be granted where a petitioner has failed to meet his or her burden of proof. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>8</sup> See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

The contention that the Office action was not received is not supported in the record and Petitioner has failed to support a petition for withdrawal of the holding of abandonment.

That condition fails to satisfy the burdens set forth in Delgar v. Schulyer.

Withdrawal of the holding of abandonment is not proper.

Petitioner's further failure to seek relief for unintentional delay<sup>9</sup> may reasonably be found to be intentional delay. Such a finding would be an absolute bar to revival.

#### ALTERNATIVE VENUE

As set forth above, Petitioner's only alternative to irretrievable abandonment is to:

- file a petition and fee as set forth at the NOTES, above at pages 1-2, under 37 C.F.R. §1.137(b), and
- state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks  
Box DAC  
Washington, D.C. 20231

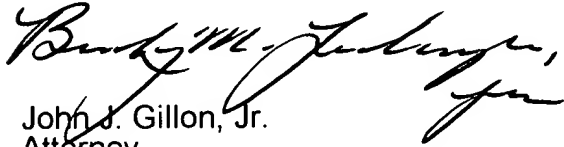
By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

---

<sup>9</sup> See: Alternative Venue, below.

Telephone inquiries should be directed to John J. Gillon, Jr., Attorney, Office of Petitions, at (703) 305-9199.



John J. Gillon, Jr.  
Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy



Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy